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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/806,336	03/23/2004	Jacques Jolivet	PHARMA-357	2203

24999 7590 10/02/2008

MILLEN, WHITE, ZELANO & BRANIGAN, PC
2200 CLARENDON BLVD
SUITE 1400
ARLINGTON, VA 22201

EXAMINER	
RAE, CHARLESWORTH E	

ART UNIT	PAPER NUMBER
1611	

MAIL DATE	DELIVERY MODE
10/02/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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MILLEN, WHITE, ZELANO & BRANIGAN, PC
2200 CLARENDON BLVD
SUITE 1400
ARLINGTON, VA 22201

In re Application of:
Jolivet et al.
Serial No.: 10/806,336
Filed: March 23, 2004
Attorney Docket No.: PHARMA-357

: PETITION DECISION

This is in response to the petition filed under 37 CFR § 1.181 on March 10, 2008, requesting that the finality of the Office action of September 11, 2007 be withdrawn; applicants contending that said final Office action was premature and thus improper. The delay in acting on this petition is regretted but only recently came to the attention of the deciding authority.

BACKGROUND

The examiner mailed a non-final Office action on December 19, 2006 setting a three month statutory limit for reply. At the time of this non-final Office action, claims 1, 3-15 and 17-60 were pending and examined. *Inter alia*, the examiner rejected claims 1, 3-15 and 17-60 on the ground of nonstatutory obvious type double patenting as being unpatentable over claims 1, 2, 3, 9, 10, 14-24, 30-36 of U.S. Patent 6,630,480 (Gourdeau '480), in view of U.S. Patent 6,747,036 (Gourdeau '036), in view of U.S. Patent 6,800,639 (Giles '639), and further in view of U.S. Patent 5,817,667 (Chu '667), and further in view of De Bono et al (J. Clin. Oncol. 2002: 20(1): 96-109, abstract only), rejected claims 1, 3-15 and 17-60, provisionally, on the ground of obviousness-type double patenting as being unpatentable over claims 11-21 of copending Application No. 10/824,563; claims 22-29 of copending Application No. 10/107,795, and claims 1-31 of copending Application No. 10/286,960, respectively, in view of Gordeau '480, in view of Gordeau '036, in view of Giles '639, in view of Chu '667, and further in view of De Bono et al

and rejected claims 1, 3-15 and 17-60 under 35 U.S.C. 103(a) as being unpatentable over De Bono et al., in view of Chu et al. (US patent 5,817,667), and further in view of Benet LZ et al.

In reply to the non-final Office action of December 19, 2006, applicants filed remarks and arguments, along with an amendment on May 14, 2007.

On September 11, 2007, the examiner mailed a final Office action setting a three month statutory limit for reply. At the time of this final Office action, claims 1, 3-15 and 17-60 were pending in the application and examined on their merits. The examiner removed the double patenting rejections as they applied to claims 1, 3-15 and 17-60 as being provisionally rejected over US application numbers 10/107,795 and 10/826,690. The examiner maintained the rejection of claims 1, 3-15 and 17-60 on the ground of nonstatutory obvious type double patenting as being unpatentable over claims 1, 2, 3, 9, 10, 14-24, 30-36 of U.S. Patent 6,630,480 (Gourdeau '480), in view of U.S. Patent 6,747,036 (Gourdeau '036), in view of U.S. Patent 6,800,639 (Giles '639), and further in view of U.S. Patent 5,817,667 (Chu '667), and further in view of De Bono et al., maintained the rejection of claims 1, 3-15 and 17-60, provisionally, on the ground of obviousness-type double patenting as being unpatentable over claims 1-31 of copending Application No. 10/286,960 in view of Gordeau '480, in view of Gordeau '036, in view of Giles '639, in view of Chu '667, and further in view of De Bono et al. and lastly, the examiner maintained the rejection of claims 1, 3-15 and 17-60 under 35 U.S.C. 103(a) as being unpatentable over De Bono et al. , in view of Chu et al. (US patent 5,817,667), and further in view of Benet LZ et al. (pages 3 and 18). Further, the examiner newly provided a reference by Lokich et al. to support each of the maintained double patenting rejections as well as the 35 U.S.C. 103(a) rejection.

With regard to the Lokich et al. citation, the examiner stated the following. This lengthy portion of the final Office action as it pertains to Lokich et al. is reiterated here due to its importance in determining the outcome of the petition decision rendered herein:

> Although there is some merit to applicant's contentions that there is a significant difference between the 30-minute duration of administration of the intravenous infusion of troxacitabine as taught by De Bono et al. ... as compared with the instantly claimed at least 72 hours infusion time ...this is not sufficient to overcome the rejection as someone of skill in the art at the time the instant invention was made would have found it obvious to create the instant claimed invention with reasonable predictability for the reasons previously made of record in the Office action mailed 12/19/06, **and as evidenced by the teaching of Lokich et al.** (Lokich et al. Dose intensity for bolus versus infusion chemotherapy administration: Review of the literature for 27 anti-neoplastic agents. Ann Oncol. 1997;8(1):15-25). Besides, it is within the knowledge and skill of an artisan skilled in the art to conduct routine experimentation to determine the therapeutically effective amount of a drug, and/or the optimal duration of infusion, and/or the optimal drug plasma/serum concentration. Lokich et al. teach that so e anti-neoplastic agents are administered as a continuous 24-hours infusion for five or more days routinely, such as 5-fluorouracil and cladrabine, while some agents, for example, fludarabine and etoposide are administered as a daily bolus for three to five days. Lokich et al. teach that the rationale for infusional administration for chemotherapeutic agents is generally based upon observing schedule dependency in experimental systems and drug pharmacology in which a short plasma half-life following bolus administration would limit tumor cell exposure; the infusion schedule may also mitigate the acute and chronic toxicities commonly associated with high) peak levels (page 15, col. 1, introduction section, lines 8-15; see also page 18, Table 3). Lokich et al. teach that infusional schedules employ various durations of administration, including 24-hour infusion repeated at weekly or longer intervals; 96-120 hour infusions; 7 or 14 day infusions; and protracted infusion for weeks or months (page 15, col. 1, line 15 to col. 2, line 3). Lokich et al. also teach that the selection of a duration

> of infusion is often arbitrary or based on achieving specific objectives such as decreasing allergic, gastrointestinal or other adverse effects; the dose intensity (DI) and the maximum tolerated dose (MTD) for infusional schedules may be different from those achieved with bolus administration and as such may influence the clinical effectiveness of the therapy.... Lokich et al. teach that an important component to infusional chemotherapy is not only the MTD but the actual duration of infusion which influences the MTD (page 23, lines 1-3). For some agents, cumulative effects with infusional administration may result in accentuated toxicity necessitating treatment interruptions, but for most drugs, adjustments in the dose rate will permit long term administration for weeks or even months (page 23, lines 3-8). Further, Lokich et al. teach that the role of treatment duration in terms of therapeutic advantage has not been unequivocably established for any agent but conceptually, the longer duration permit a protracted exposure to the neoplastic cell optimizing the potential for a drug-cell interaction ... (page 23, col. 1, lines 8-18). The below discussion of the 103(a) rejection is also incorporated by reference. (pp. 10-11 final Office action, emphasis by underline in the examiner's original statements, emphasis in bold added herein).

On January 11, 2008, applicants submitted a reply under 37 C.F.R. § 1.116 in response to the final Office action mailed September 11, 2007. Within this reply, applicants submitted arguments in rebuttal to the rejections set forth in said final Office action, as well as a specific request to the examiner to withdraw the finality of said Office action; applicants asserting that the final Office action raised new grounds of rejection which were not necessitated by applicants' amendments to the claimed invention.

On February 12, 2008, the examiner mailed an Advisory Action indicating that applicants' request for reconsideration was considered, but not found persuasive. In particular, with regard to applicants' allegation that the rejection of claims 1, 3-15 and 17-60 under 35 U.S.C. 103(a) was a new ground of rejection, the examiner replied in this Advisory: "[c]learly, Lokich et al. is only cited as evidence to show the general state of the art (see Office action mailed 9/11/07, page 24, second full para)."

In response thereto, applicants filed this petition under 37 CFR § 1.181 on March 10, 2008, requesting that the finality of the Office action of September 11, 2007 be withdrawn; applicants contending that said final Office action was premature and thus improper.

DISCUSSION

The petition and the file history have been carefully considered.

In the petition filed on March 10, 2008, applicants argue that the examiner's inclusion of the Lokich et al. reference in the double patenting rejections as well as the 35 U.S.C. 103(a) rejection in the final Office action constituted a new ground of rejection which was not necessitated by applicants' amendment to the claimed invention. While the examiner asserts on the record that Lokich et al. was placed merely to support the maintained rejections in the final Office action by providing the general state of the art; applicants, to the contrary, argue that the examiner's use of Lokich et al. was used in a more substantive manner by the examiner; specifically, to provide additional motivation as to render obvious the claimed duration of infusion administration as instantly claimed.

Applicants' arguments are well-taken. While the examiner stated on the record that the citation to Lokich et al. in the final Office action was merely to show the state of the art, the examiner's use of the Lokich et al. reference in the final Office action was clearly more substantive in nature than the examiner contends. The proper use of extrinsic evidence is to provide proof or rationale that a characteristic element, not explicitly stated in a primary reference, is necessarily present (i.e., inherent), to provide a meaning of a claim term or to demonstrate that the cited reference possesses an enabling disclosure (see, for example MPEP § 2131.01 for a discussion of when extrinsic evidence is appropriate for use in rejections). However, such is not the case in the placement of Lokich et al. into the rejection made by the examiner under 35 U.S.C. 103(a) in the final Office action. Lokich et al. is substantively used in said rejection to provide a quite lengthy rational by the examiner to adjust the 30 minute duration of administration of intravenous infusion as taught by De Bono et al. to the claimed 'at least 72 hours' of infusion time required by the claimed invention. Hence, the examiner's apparent use of the Lokich et al. reference as extrinsic evidence in the rejections set forth in the final Office action was inappropriate as the Lokich et al. reference plainly *provides motivation* to adjust the duration of infusion. Thus, the rejections set forth *"...as supported by Lokich et al"* as instituted by the examiner in the final Office action are all considered new grounds of rejection.

The only claim amendments made by applicants in the interim between the non-final Office action and the final Office action are found in the response filed on May 14, 2007 and are considered informal in nature. Thus, these claim amendments did not necessitate said new grounds of rejection placed by the examiner in the final Office action.

Therefore, applicants' arguments are found persuasive that the final Office action issued September 11, 2007 was improper and premature. Thus, the finality of said Office action will be withdrawn.

DECISION

The petition is **GRANTED.**

This application will be forwarded to the examiner for an action not inconsistent with this decision.

Should there be any questions about this decision please contact Marianne C. Seidel, by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0584 or by facsimile sent to the general Office facsimile number, 703-872-9306.

George C. Elliott

George Elliott
Director, Technology Center 1600